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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,455	08/13/1999	Michael P. Daniels	54642USA1A	4367

32692 7590 03/18/2003

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
ST. PAUL, MN 55133-3427

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/18/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/367455

Filing Date: 8/13/99

Appellant(s): Daniels et al.

**MAILED**  
MAR 17 2003  
**GROUP 1700**

Paper No. 16

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Carolyn Peters

For Appellant

Art Unit: 1714

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/16/03.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

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**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

The rejection of claims 1-10 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

4,569,960

BLAKE

2-1986

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

I. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4569960 Blake.

Blake discloses a psa and method of making it which fall within the scope of the instant claims at the abstract; column 2, lines 42-68; column 3, lines 1-68; column 4, lines 1-18; column 7, lines 1-31; column 8, lines 1-31; the table of columns 11-12, particularly examples 73-75; and the patented claims. Appellant argues that anticipation requires identity of invention. The appellant has not shown that the psa of Blake is different than that of the instant claims. The appellant argues that the instantly claimed invention retains its "stick" properties, even in water. The instant claims recite "wet" but not wet with water. The appellant

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argues the definition of water dispersibility. The instant claims do not exclude water dispersibility. The examiner would point out that water dispersible resins are commonly applied to substrates in the form of the aqueous dispersion, eg latex paints/adhesives. The substrate is necessarily wet in such applications and the resin still binds to the substrate. Thus, the reference water dispersible psa would have been expected to stick to wet substrates. The appellant provides no probative evidence to the contrary which is commensurate in scope with the instant claims and the cited prior art. The presumption made in the appellant's arguments is therefore not persuasive.

II Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4569960 Blake.

Blake discloses a psa and method of making it which fall within the scope of the instant claims at the abstract; column 2, lines 42-68; column 3, lines 1-68; column 4, lines 1-18; column 7, lines 1-31; column 8, lines 1-31; the table of columns 11-12, particularly examples 73-75; and the patented claims. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients and amounts thereof in the psa of the patentee because they are encompassed by the patentee and would have been expected to give a psa having the properties of the psa of the patentee. The appellant argues that the instantly claimed invention retains its "stick" properties, even in water. The instant claims recite "wet" but not wet with water. The appellant argues the definition of water dispersibility. The instant claims do not exclude water dispersibility. The examiner would point out that water dispersible resins are commonly applied to substrates in the form of the aqueous dispersion, eg latex paints/adhesives. The substrate is necessarily wet in such applications and the resin still binds to the substrate. Thus, the reference water dispersible psa would have been expected to stick to wet substrates. The appellant provides

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no probative evidence to the contrary which is commensurate in scope with the instant claims and the cited prior art. The presumption made in the appellant's arguments is therefore not persuasive.


**(11) Response to Argument**

I. The instant claims do not exclude the hydroxide salt of the patentee by definition of "comprising". Contary to the appellant's assertion, "water-dispersible" does not exclude the argued properties because, upon evaporation of the continuous phase, the binder particles coalesce into a continuous film that adheres to surfaces that were necessarily wet with the water of dispersion, as would be appreciated by the ordinary skilled artisan and anyone who has used latex paint or adhesive. The appellant's statement that "the adhesives of the present invention may not even be sticky under dry conditions" is inconsistent with the recitation "pressure sensitive adhesive" of the instant claims. Furthermore, in any event, it is not seen that the same is not true of the patentee's adhesive nor is this required by the instant claims. The instantly claimed hydrophilic polymer necessarily has the ability to be dispersed in water. For these reasons, the rejection of paragraph 10 I above should be affirmed.

II. For the reasons stated in paragraph 11 I above, the rejection of paragraph 10 II above should be affirmed.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Patrick Niland  
Primary Examiner  
Art Unit 1714

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March 13, 2003

Conferees

Vasu Jagannathan

*Vasu Jagannathan*

James Siedleck

*James Siedleck*

Carolyn Peters

Office of Intellectual Property Counsel

3M Innovative Properties Company

P.O. Box 33427

St. Paul, MN 55133-342